

## **REMARKS**

### **Status of the Application**

Claims 1, 5-6, 8, 13, 18, 23, 30-32, 34-36, and 41 are currently pending. Of those claims, claims 35-36 are withdrawn due to an earlier restriction requirement.

With this Reply, Applicants have canceled claims 16-17, 44, 49, 52-53, 55, 64, 70, 74, 76, 78, and 80 without prejudice or disclaimer and amended claims 1 and 8. Specifically, claims 1 and 8 are amended to recite that the first polypeptide amino acid sequence comprises SEQ ID NO:215. Furthermore, the clause at the end of each of claims 1 and 8 reciting that the polynucleotide or polypeptide "is an isolated molecule" is essentially moved to the preamble of each claim so that the claims now recite "An isolated" nucleic acid or polypeptide molecule. Claims 35 and 36 are also amended to make them dependent on claims 23 and 8, respectively, and to replace the reference to claim 1 by the text of claim 1. These amendments are supported by the originally filed claims and thus introduce no new matter.

### **Request for Rejoinder of Claims 35-36**

Claims 35 and 36 are method claims that depend from elected claims 23 and 8, respectively. Upon allowance of claims 23 and 8, Applicants request the rejoinder of claims 35 and 36 according to the policy established in M.P.E.P. § 821.04. According to that policy, "if [the] applicant elects claims directed to [a] product, and [the] product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." *Id.* Applicants also note that according to the doctrine of *In re Ochiai*, 37 U.S.P.Q.2d 1127

(Fed. Cir. 1995), process claims that employ a novel and nonobvious product, as here, are also novel and nonobvious.

#### **Rejection under 35 U.S.C. § 101**

Claims 1, 5-6, 8, 13, 16-18, 23, 30-32, 34 and 41 are rejected as allegedly incorporating non-statutory subject matter. The Examiner requests that the claims be amended to state "isolated" nucleic acid or polypeptide molecules. (Office Action at 3-4.)

Applicants note that independent claim 1 as filed already recited that "the nucleic acid molecule is an isolated molecule" and that claim 8 as filed already recited that "the polypeptide is an isolated molecule." Thus, no claim amendment should be necessary. However, merely for further clarity, Applicants amend those claims to recite the word "isolated" at the beginning of each claim rather than at the end of each claim.

Thus, Applicants request the withdrawal of this rejection.

#### **Rejection under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claims 1, 5-6, 8, 13, 16-18, 23, 30-32, 34 and 41 as allegedly indefinite for the recitation of a "biologically active fragment" in claims 1 and 8. (Office Action at 4-5.) Without acquiescing to this rejection, Applicants note that in light of the above claim amendments, this rejection is now moot. Thus, Applicants request its withdrawal.

#### **Rejection under 35 U.S.C. § 112, First Paragraph, Written Description**

The Office rejects claims 1, 5-6, 8, 13, 16-18, 23, 30-32, 34 and 41, contending they lack written description support in relation to "biologically active fragments" of SEQ

ID NO:215. (Office Action at 5-11.) Without acquiescing to this rejection, Applicants note that in light of the above claim amendments, this rejection is now moot. Thus, Applicants request its withdrawal.

**Rejection under 35 U.S.C. § 112, First Paragraph, Enablement**

The Office rejects claims 1, 5-6, 8, 13, 16-18, 23, 30-32, 34 and 41, for an alleged lack of enablement. (Office Action at 11-16.) The Office acknowledges, however, that the claims are enabled for “an isolated polypeptide comprising the amino acid sequence of SEQ ID NO:215 and corresponding nucleic acid sequence.” (*Id.* at 11.) Without acquiescing to this rejection, Applicants submit that due to the above claim amendments, this rejection is now moot. Thus, Applicants request its withdrawal.

**Rejection under 35 U.S.C. § 102(b)**

Lastly, the Office rejects claims 1, 5-6, 8, 13, 16-18, 23, 30-32, 34 and 41 for allegedly lacking novelty. (Office Action at 16-17.) Specifically, the Office contends that SEQ ID NO:1 of WO 00/55200 has 43.4% identity with SEQ ID NO:215. (See *Id.*)

To establish a *prima facie* case of anticipation under 35 U.S.C. § 102, each and every element claimed must be recited in a single item of prior art.

Because the sequence from WO 00/55200 only shows 43.4% identity with SEQ ID NO:215 according to the Office, it does not encompass all of the elements of independent claims 1 and 8. Therefore, WO 00/55200 cannot anticipate independent claims 1 and 8 or any of their dependent claims. Accordingly, Applicants request the Office to withdraw this rejection.

**Conclusion**

In light of the amendments and remarks above, claims 1, 5-6, 8, 13, 18, 23, 30-32, 34 and 41 are in condition for allowance and Applicants respectfully request the timely allowance of those claims and the rejoinder of claims 35 and 36. If the Examiner has any questions regarding the above amendments or remarks, she is invited to contact Applicants' representative at her convenience.

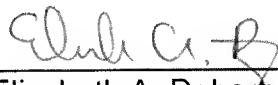
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 2, 2010

By: \_\_\_\_\_

  
Elizabeth A. Doherty  
Reg. No. 50,894